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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,153	08/27/2001	Manceesh Bahadur	DC4945	7086

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EXAMINER

MCCLENDON, SANZA L

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/940,153

Examiner

Sanza L McClendon

Applicant(s)

BAHADUR ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2001 .
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 22-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 17-20 is/are rejected.
- 7) ☒ Claim(s) 15, 16 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____ .

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DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-21, drawn to radiation curable composition, classified in class 522, subclass 99.

II. Claims 22-24, drawn to method, classified in class 427, subclass 508.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the composition could be molded verse coated.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. Zombeck on 6/12/02 a provisional election was made with traverse to prosecute the invention of I, claims 1-21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 22-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Information Disclosure Statement

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1. The information disclosure statement (IDS) submitted on 2/27/2001 in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement. However, the reference to serial number 09/569,283 is not in the proper location, it should be listed in the "other document" section of the PT0-1449. It has been considered for the purposes of examination, however it will not appear on the face of the Patent when and/or if the applicant is ready for allowance. If applicants would like serial number 09/569,283 to appear on the Patent a new PT0-1449 would need to be submitted with said document serial number in the proper location.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-13, and 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. In the claims 1-12 and 17-20 the applicant(s) have employed or used improper Markush language, i.e., selected from, in defining the Markush grouping of claims 1-12, and 17-20; and have used the term "and" to link the last two members or only two members of the Markush grouping. The applicants should have used the term "or" instead. The conjunction or term "and" is used when proper Markush language is employed, i.e., "selected from the group consisting of". See M.P.E.P. 2173.05(h).

Pat

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment

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by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-8, 13-14, and 19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, and 9-14 of U.S. Patent No. 6,069,185. Although the conflicting claims are not identical, they are not patentably distinct from each other because US Patent number 6,069,185 claims a radiation curable composition comprising (A) an alkenyl ether functional polyisobutylene polymer which has at least 50 mole percent of a non-terminal repeating unit of the polymer are isobutylene units and contains at least one group having the formula found in claims 1 and 19 with the corresponding definitions found in dependent claims, (B) a cationic photoinitiator; and (C) a free radical photoinitiator, wherein said composition can further comprise a component (D) an alkenyl ether compound that is free of isobutylene units having the formula (i) found in claim 12 with the definitions found in claims 12 and 13. There is substantial overlap in the combination of claims 1-5 and 12 with the instant application. Component (Di) in 6,069,185 reads on component (C-iii) of the instant application. Claims 6-7 and 9-10 provide substantial overlap with claims 6-7, and 13-14 of the instant application.

7. Claims 1-9, 13-14, and 19-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 11-12, 17-18, and 22 of copending Application

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No. 09/569,283. Although the conflicting claims are not identical, they are not patentably distinct from each other because serial number 09/569,283 claims a radiation curable composition comprising (A) an alkenyl ether functional polyisobutylene polymer which has at least 50 mole percent of a non-terminal repeating unit of the polymer are isobutylene units and contains at least one group having the formula found in claim 1 with corresponding definitions in dependent claims, (B) a cationic photoinitiator; and (C) a miscible reactive diluent selected from (i) difunctional vinyl ether reactive diluents and (ii) an acrylate reactive diluent. Wherein, said composition can further comprise free radical photoinitiators, such as those listed in claims 17-18, and 22. Said cationic photoinitiators can be selected from the listed in claims 6-7. Said free radical photoinitiators can be found in claim 22. Wherein there is substantial overlap of subject matter within claims 1-9, 13-14, and 19-20 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

8. Claims 15-16, and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to teach a radiation curable composition, a method of making said radiation curable composition, and a method of making an article of manufacture; comprising (A) an alkenyl ether functional polyisobutylene polymer which has at least 50 mole percent of a non-terminal repeating unit of the polymer are isobutylene units and contains at least one group having the formula found in claim 1, (B) a cationic photoinitiator; and (C) a miscible reactive diluent selected from (i) difunctional vinyl ether reactive diluents; (ii) an acrylate reactive diluent; (iii) a mono-functional vinyl ether reactive diluent; and (iv) an epoxy functional diluent, wherein said composition further comprises an adhesion promoter.

Conclusion

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L McClendon whose telephone number is (703) 305-0505. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0657.

Sanza L McClendon
Examiner
Art Unit 1711

SMc

December 13, 2002


James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700